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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,878	09/11/2003	Shridhar P. Joshi	47079-00225USPT	5010
70/243	7/5/90	06/09/2009		
NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606			EXAMINER MOSSER, ROBERT E	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,878

Applicant(s)

JOSHI ET AL.

Examiner

ROBERT MOSSER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant Admitted Prior Art

The Examiner presented Official notice in the office action dated March 28th, 2007 that the utilization of identical gaming machines in a pari-mutuel jackpot system such as taught by Celona is exceptionally old and well known in the art. This notice was not challenged in the subsequent reply by Applicant, accordingly this feature is considered Applicant admitted prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The independent claims as presented set forth a first progressive jackpot and a second multi-level progressive jackpot awarded to a player resultant of a first and second game outcome and wherein the first and second jackpot have at least the respective value of a first reserve amount and a second reserve amount defined as greater than the first amount and jackpot accrues at a first and second accrual rate respectively

Claim 1-2, 5-8, 11-12, 15-23, and 26-27 rejected under 35 U.S.C. 103(a) as being unpatentable over Celona (US 5,564,700) in view of Green (US 5,538,252) in yet further view of Canon (US 5,344,144).

Claims 1, 8, 12, and 26: Celona teaches a method of playing a wagering game including a base game with a randomly selected game outcome (*Celona* Col 4:28-34) and allowing the player to present a base wager and in addition thereto an additional wager amount in the form of a max bet (*Celona* Col 3:52-4:15). Responsive to the presence of a max wager the player is eligible to receive a special progressive jackpot payout consisting of first payout/award equal to half of a progressive jackpot and a second payout/award equal to a percentage of the remaining portion of the jackpot that is in turn distributed among the remaining eligible players who did not receive the first payout upon awarding of the jackpot prize (*Celona* Col 3:58-62 & 3:44-47). Celona however is silent regarding explicitly teaching a base wager and a side wager as two distinct wagers however, in a related progressive wagering system, Greene teaches the separation of a basic wager and side wager for participation in a multi-level progressive environment (*Green* Col 12:20-13:51). Green further teaches that the multi-level progressive jackpots are presented to the player reflective of achieving a joker outcome in a single game play (*Green* Col 12:28-13:48). As the base game payout and the jackpot wagers are distinct, this is understood to additionally convey that the player

receives a first respective award amount for achieving a winning hand in the base game and a secondary payout responsive to the placement of a press wager. It would have been obvious to one of ordinary skill in the art at the time of invention to have separated the game wager and side wager into two distinct wagering events in the game of Celona as taught by Green in order to allow a player to place a maximum base game wager without requiring participation in the progressive payout and alternatively allow the player to participate in the multilevel progressive payout without requiring a maximum base game wager.

The combination of Celona/Green as presented above is silent regarding the specific funding the jackpot comprising a first and second reserve amount and in addition thereto comprising and contributing a first and second percentage to each respective jackpot in a manner such that the second reserve amount is greater than the first reserve amount and reflective therewith the second contribution percentage is greater than the first contribution percentage. With respect to these features however Canon 144' teaches the utilization of respective jackpot pools of differing reserve amounts as well as different contribution rates associated with the respective jackpot pools (Canon 144' Figure 4, Col 4:19-48, 6:49-68). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the plurality of progressive jackpot of Cannon into the combination of Celona/Green in order to allow the size of progressive jackpots to reflect the probability of occurrence of the respective game outcomes. Given the teaching Canon 144' teaches pools and contribution rates of different amounts one of these respective amount must by definition be greater than

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remainder amount. While this inherent teaching provides for the separation based on a first accrual rate and reserve amount according to magnitude it does not necessarily indicate separation would be reflective of the respective magnitudes in combination. Accordingly the association of the that the greater/lesser reserve amounts and the respective greater/lesser contribution rates is understood as being obvious to one of ordinary skill in the art at the time of invention for representing an instance one skilled in the art is choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success (*KSR International Co. v. Teleflex Inc.*). In this instance the finite number of solutions would be the particular association between the two different accrual rates and two different reserve amounts yielding four possible combinations of these known elements.

Claims **2**, and **27**: In addition to the above, the combination Celona/Green/Canon teaches the incorporation of a third payout based on the randomly selected game outcome as a conventional game payout (*Celona* Col 4:35-40), a local jackpot payout (*Celona* Col 4:40-42), however is arguably silent regarding the third payout being of a "progressive" type. Celona/Green/Canon further teach the presentation a multilevel progressive jackpot (*Green* Col 12:20-13:51). As provided it would have been obvious to one of ordinary skill in the art at the time of invention to have transformed the local jackpot of Celona into a local progressive jackpot in order to ensure that the local jackpot increases with play.

Claims **5-7**, and **16-18**: In addition to the above, the combination of Celona/Green/Canon teaches that the game machine may be of a slot type and a poker

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type wherein both machine types are understood to inherently contain a plurality of symbols (e.g. cards and slot machine wheel symbols) and further that a slot machine game inherently includes slot machine reel symbols while a poker game inherently includes card symbols for a deck of playing cards (*Celona* Col 1:17-20, 6:28-33).

Claim 11: In further addition to the above, the combination of Celona/Green/Canon teaches an awarding step cited in the redress of at least claim 1 above is performed by the controller located in the gaming terminal through the dispensing of an award amount (*Celona* Col 4:48-56, Elm 342 Col 6:45-50).

Claim 15: In further addition to the above, the combination of Celona/Green/Canon teaches the use of a button for initiating play of the gaming machine upon the deposit of a wager (*Celona* Col 4: 16-20, 4:29-34). As the player must activate the button in order to commence play the side wager device of Celona is understood to incorporate a button.

Claim 19: In further addition to the above, the combination of Celona/Green/Canon teaches the incorporation of a plurality of gaming terminals wherein each terminal incorporates the side wager input device (*Celona* Figure 1).

Claims 20-22: In further addition to the above, the combination of Celona/Green/Canon teaches the incorporation of signage displaying the special jackpot payout, wherein the signage is located above, and coupled to the plurality of gaming device through a signage controller and terminal controllers. The signage and signage controller are further configured to receive a signal that at least one of a plurality of gaming machines

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is eligible to receive the special jackpot payout (*Celona* Elm 308, 338 Col 6:51-7:51, 8:42-50, 9:1-3, Figure 3).

Claim 23: The combination of *Celona*/Green/Canon teaches the claimed invention as set forth above and including multiple gaming machines (Figures 1-3) however, is silent regarding explicitly teaching that the plurality of gaming machine utilized are identical gaming machines. It is Applicant admitted prior art that the utilization of identical gaming machines in a pari-mutuel jackpot system such as taught by *Celona* is exceptionally old and well known in the art. It therefore would have been prima facie obvious to have utilized the system of *Celona* with a plurality of identical gaming machine in order to promote the use of a particular gaming machine over comparative non-pari-mutuel jackpot systems.

Claims **4, 9-10, 14, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Celona* (US 5,564,700) in view of *Green* (US 5,538,252) in further view of *Canon* (US 5,344,144) in yet further view of *Canon* (US 6,800,026).

Claims 4, 14, and 25: The combination of *Celona*/Green/Canon teaches the claimed invention as set forth above however, is silent regarding award a bonus game as a special payout. In a related invention *Canon* teaches awarding bonus games conditioned on placement of a max bet (*Canon* Col 8:62-66). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the bonus game as a prize outcome in the game of *Celona* in order to provide an award

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outcome that would allow a plurality of participants to interact in a competitive environment (*Canon* Col 2:41-44).

Claim 9-10: The combination of Celona/Green/Canon teaches the claimed invention as set forth above however is silent regarding slot machines including a plurality of paylines and requiring all of these pay lines to be utilized by the player to qualify for a bonus round, however the reference Canon teaches this feature (*Canon* Col 8:62-66).

It would have been obvious to one of ordinary skill in the art to have utilized slot machines with a plurality of paylines and requiring all of these pay lines to be utilized by the player to qualify for a bonus round to increase the size of the maximum wager while additionally increasing the player's ability to achieve a positive outcome in the base game.

Response to Arguments

Applicant's arguments filed March 3rd, 2009 have been fully considered but they are not persuasive.

(A) Green is not relied upon for teaching the applicant's described ambiguous features

On pages 9 through 10 of the applicant's remarks the applicant alleges that the Press feature of Green is "Ambiguous" and not defined in a manner that one of ordinary skill would be capable of deducing the mechanics of the award from the specification of Green. Specifically and as best understood the applicant challenges the teachings of Green for providing an explicit teaching regarding the funding of the levels of the multi-level progressive pool with respective separate pools.

However it is noted that Green is not relied upon for providing an explicit teaching regarding the funding of the levels of the multi-level progressive pool with respective separate pools. Green provides the inclusion of a multiple level progressive while the prior art of Canon provides for the aspects of associating differing prize pools with respective multi-level progressive prizes.

(B) The applicant's allegations that the combination of references is improper for teaching away are non-persuasive.

Specifically the applicant alleges that the modification of prize pool system of Green under the teachings of Canon would be improper because in the alleged teaching of Green of a common pool there would be an implicit teaching away from the method taught by Canon. However the teaching of a differing method by one reference does not impinge on the obviousness of utilizing another differing method for performing the same operation. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Applicant's reference to MPEP 2143.01.VI and arguments associated therewith fail to establish how the implementing the known and differing prize system of Cannon would result in the non-operability of the game of Green. Suggestions that the implementation of an alternative prize system in place of the one taught by Green would result in the non-operability of the prize system of Green are respectfully circular in nature as any modification which would result in a device or

system different than the system or method taught by the base reference would carry the same effect.

Further arguments contained within this section suggest that the resultant combination proposes taking opposite methods than suggested by either the Green or Cannon reference and therewith that the holding of obviousness is based on the misinterpretation of the obviousness standards. These arguments are respectfully non-persuasive, as the alleged teaching away is not reflective of the combination as applied, and the proposed obviousness standards are not reflective of the standards as presented by the MPEP and present line a reasoning that would contradict not only the applied combination of reference but any combination of references wherein a modification to the original presentation of a reference was modified.

C. The combination of references provide for different multi-level jackpot prizes awarded for different game outcomes

The applicant characterizes Green as providing the same jackpot prize for various game outcomes on page 12 of their remarks however, this statement is in error. Green provides for multiple jackpot prize amounts for different game outcomes drawn from the same jackpot prize pool (Col 11:16-44). Characterizing the Jackpot prize of Green as being the same prize because they are drawn from the same common pool does not accurately characterize that the prize amounts vary according to the multi-level progressive prize as taught by Green. The separation of the common jackpot prize pool of Green is taught by the prior art reference of Celona as cited above. The arguments

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of this section generally address the teachings of green, the combination of Celona and Canon. and the combination of Green and Canon but notably do not address the combination of Green Celona and Canon beyond a statement of mere allegation.

Accordingly and in view of the above, the rejections under the combination of Green, Celona and Canon are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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